

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE
Serial Number: 10/758,967
Filing Date: January 16, 2004
Title: IMPACT RESISTANT WINDOW ASSEMBLY

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REMARKS

This responds to the Office Action dated November 1, 2007 (hereinafter "Office Action"). Claims 7, 9 and 27-28 are currently amended and fully supported by the application as filed, such as at p. 5, l. 30 – p. 6, l. 8; p. 6, ll. 16-26; and FIGS. 2B-3. Claim 34 is new and fully supported by the application as filed, such as at p. 5, ll. 15-23 and FIG. 1. Claims 14-22 were previously cancelled without prejudice or disclaimer. As a result, claims 1-13 and 23-34 are currently pending and responded to below.

Applicants hereby respectfully request further examination and reconsideration of this application in view of the foregoing claim amendments and following remarks.

Request for Interview

1. Prior to the Office issuing any subsequent communications, Applicants respectfully request a telephonic interview at the Examiner's convenience. Applicants' attorney Gregory W. Smock can be reached by telephone at (612) 373-6956.

§103 Rejection of the Claims

2. Claims 1-13 and 23-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Diginosa (US 6,135,510) (hereinafter "Diginosa") in view of Merz et al. (US 1,570,072) (hereinafter "Merz"). Applicants respectfully request reversal of these rejections on the ground that there is no *prima facie* case of obviousness.

Claim 1:

Applicants submit that the proposed combination of Diginosa and Merz is improper and fails to establish all elements recited in Applicants' claims. Claim 1, for example, recites an impact resistant window assembly comprising a bracket assembly disposed "within the recess" of a window jamb surface. The Office Action admits that Diginosa fails to recites a bracket assembly disposed within a recess of a window jamb surface. (Office Action at 2.) Instead, the Office Action attempts to rely on Merz to establish this missing element. (*Id.*) Applicants submit on numerous grounds, however, that no legally sufficient motivation exists to combine

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the teachings of Diginosa and Merz to make the specific combination recited in Applicants' claim 1.

First, Diginosa teaches away from being combined with Merz and further teaches away from Applicants' claimed combination. As recognized by the Office Action, Diginosa recites a bracket assembly disposed "on" a window sash face and having a bracket portion adapted to slidably insert "into" the recess of a window jamb. (*Id.*) In contrast, Merz and the Applicants' claimed combination recite a bracket assembly disposed "within" a window jamb recess and having a bracket portion movable "out of" the jamb recess. (Office Action at 2-3.) According to the Federal Circuit, an invention is not obvious where one prior art reference teaches away from combination with a second prior art reference. *In re Rudko*, Civ. App. No. 98-1505 (Fed. Cir. May 14, 1999) (unpublished). In addition, the Federal Circuit has ruled motivation to combine references is lacking when the reference(s) teach away from the claimed combination. See *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986) (A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered). Because Diginosa teaches away from combination with Merz and the Applicants' claimed combination, the asserted combination of references is improper and fails to establish all elements recited in claim 1.

Second, the proposed combination of Diginosa and Merz would result in a reference inoperable for its intended purpose as prohibited by the Federal Circuit's holding in *In re Gordon*, or at the very least, require substantial redesign as prohibited by the CCPA's holding in *In re Ratti*. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Diginosa recites a window lock having a locking member movable to an intermediate projecting position allowing a window sash to "slidably ride" within a continuous jamb trackway to numerous sash positions. For example, Diginosa states:

The invention resides in providing a lock for a slideable and tiltable or swingable window sash of a window unit, the lock . . . having a bolt end slideable in the housing slideway to move the bolt end [to] an intermediate projecting position for riding in a trackway to retain and guide the window sash for sliding movement.

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(Diginosa at col. 1, ll. 59-67; *see also* Abstract and col. 6, ll. 16-29.) In contrast, Merz recites non-continuous recesses for locking a “single position” of an insert frame relative to a door. For example, Merz states:

[F]or receiving the projected locking bars [of the door,] the insert frame has the kerfs or recesses 28 formed therein, and the beveled under surfaces of the locking bars engage against the inner sides of these kerfs in order to clamp the insert frame to the door with weather tight engagement.

(Merz at p. 1, ll. 90-98; *see also* FIG. 1.) Because the combination of Merz with Diginosa would result in a reference inoperable for its intended purpose (e.g., a window sash precluded from “slidably riding” within a continuous jamb trackway), the asserted combination of references is improper and fails to establish all elements recited in claim 1.

Third, the Office Action asserted motivation for combining Diginosa and Merz runs afoul of the Federal Circuit’s holding in *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 53 U.S.P.Q.2d 15080 (Fed. Cir.), *cert. denied*, 530 U.S. 1238 (2000). According to the Office Action, it would have been obvious to one having ordinary skill in the art to combine Diginosa and Merz because having the bracket assembly mounted within a jamb recess (as assertedly taught by Merz) would provide the “same function” of slidable locking of the window sash as the external mounting of the bracket assembly (as recited by Diginosa). (Office Action at 3.) If Diginosa and Merz provide the “same function” as asserted, it follows that the motivation to combine such references would not stem from the “nature of the problem” facing one of ordinary skill in the art because no “problem” would be perceived. To this end, the Federal Circuit has previously held “[t]rade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter.” *Winner Int’l Royalty Corp.*, 53 U.S.P.Q.2d 15080. Because there is no objective motivational evidence of record for the Office Action’s assertion that it would have been obvious to combine the teachings of Diginosa and Merz, Applicants respectfully request withdrawal of this basis of rejection of claim 1.

Moreover, Applicants’ claim 1 additionally recites a bracket portion having a first recessed position and a second position in which the bracket portion is disposed “over” a portion of the “interior” portion of the sash. The Office Action admits that Diginosa fails to recites a bracket portion disposed over the interior of a sash at a second position. (Office Action at 2.) Instead, the Office Action attempts to rely on Merz to establish this missing element. (*Id.* at 3.)

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Applicants submit, however, that Merz fails in this regard. Rather than reciting a bracket portion disposable "over" the "interior" of a sash, Merz recites a bracket portion disposable "within" a "recess" of an insert frame (i.e., the asserted sash). For example, as remarked above, Merz states:

[F]or receiving the projected locking bars [of the door,] the insert frame has the kerfs or recesses 28 formed therein.

(Merz at p. 1, ll. 90-94; *see also* FIG. 1.) According to the MPEP § 2142, the prior art reference(s) must teach or suggest all of the claim elements. Because Diginosa and Merz, alone or in combination, fail in this regard, Applicants respectfully request reconsideration and withdrawal of this basis of rejection of claim 1.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this basis of rejection of claim 1. Claims 2-7, 31-32 and 34 are dependent on claim 1 and are patentable over the cited references for the reasons remarked above, in addition to the elements in such claims.

Claim 3:

Additionally, regarding claim 3, Applicants cannot find in Diginosa nor Merz any recitation of a bracket assembly "substantially concealed" in the window jamb assembly from a "frontal view" when the bracket portion is disposed in the first position. Rather, Diginosa and Merz recite an unconcealed bracket assembly disposed on or nailed to "the face" of a sash or jamb. (See Office Action at 2.) For example, Diginosa states:

With the lock 4 mounted to the face of the sash frame member or jamb 10, the locking member 19 has three operating positions.

(Diginosa at col. 4, ll. 14-19; FIGS. 1-2.) For example, Merz states:

[T]he door frame is routed out with a dove-tail bit to form the dove-tail channel 22 for receiving the dove-tail sided body 16, such joint engagement assembly securely locking the body 16 so that a few brads 23 driven through the flange holes 24 into the door frame will be sufficient to hold the locking device against displacement.

(Merz at p. 1, ll. 73-80; FIG. 1.) According to the MPEP § 2142, the prior art reference(s) must teach or suggest all of the claim elements. Because Diginosa and Merz, alone or in combination, fail in this regard, Applicants respectfully request reconsideration and withdrawal of this basis of rejection of claim 3.

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Claim 7:

Additionally, regarding claim 7, Applicants cannot find in Diginosa nor Merz any recitation of one or more fasteners securing a bracket assembly to an outer frame "surrounding" the window jamb assembly. Rather, Diginosa and Merz recite the securing of one or more fasteners to a sash or jamb. For example, Diginosa states:

Suitable fasteners 28b [sic] projected through the openings 27a and columns 27 enable the housing 18 to be easily and quickly fastened at an appropriate position on the sash.

(Diginosa at col. 4, ll. 59-62; FIG. 5.) For example, as remarked above, Merz states:

[A] few brads 23 [are] driven though the flange holes 24 into the door frame [i.e., the asserted window jamb] [] sufficient to hold the locking device against displacement.

(Merz at p. 1, ll. 77-80.) According to the MPEP § 2142, the prior art reference(s) must teach or suggest all of the claim elements. Because Diginosa and Merz, alone or in combination, fail in this regard, Applicants respectfully request reconsideration and withdrawal of this basis of rejection of claim 7.

Claim 32:

Additionally, regarding claim 32, Applicants cannot find in Diginosa nor Merz any recitation of a bracket portion including a "tool access port" on a "leading edge thereof." In fact, Applicants submit neither Diginosa nor Merz has a need for a tool access port as each reference recites adequate means to facilitate engaging movement of the asserted bracket portions. For example, Diginosa recites an upward extending "finger grip" on a trailing edge of the asserted bracket portion, and Merz recites an upward deflected locking bar on a trailing edge of the asserted bracket portion. Thus, Applicants assert that the modification of Diginosa and Merz to include the claimed tool access portion amounts to a mere trade-off. As stated by the Federal Circuit, "[t]rade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter." *Winner Int'l Royalty Corp.*, 53 U.S.P.Q.2d 15080.

For at least this reason, Applicants respectfully request reconsideration and withdrawal of this basis of rejection of claim 32.

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Claim 8:

Applicants submit that the proposed combination of Diginosa and Merz is improper and fails to establish all elements recited in Applicants' claim 8. To this end, Applicants respectfully incorporate herein the relevant remarks asserted above with respect to claim 1 (i.e., among other things, (1) Diginosa teaches away from being combined with Merz and further teaches away from the Applicants' claimed combination; (2) the proposed combination of Diginosa and Merz would result in a reference inoperable for its intended purpose, or at the very least, require substantial design; (3) the Office Action asserted motivation for combining Diginosa and Merz amounts to no more than a mere trade-off; and (4) neither Diginosa nor Merz recites a bracket portion providing reinforcement to the "interior" portion of a sash at a second position).

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this basis of rejection of claim 8. Claims 9-13 are dependent on claim 8 and are patentable over the cited references for the reasons remarked above, in addition to the elements in such claims.

Claim 9:

Additionally, regarding claim 9, Applicants cannot find in Diginosa nor Merz any recitation of one or more fasteners securing a bracket assembly to an outer frame "surrounding" the window jamb assembly. To this end, Applicants respectfully incorporate herein the relevant remarks asserted above with respect to claim 7 (i.e., Diginosa and Merz recite the securing of a base plate to a sash or jamb).

For at least this reason, Applicants respectfully request reconsideration and withdrawal of this basis of rejection of claim 9.

Claim 13:

Additionally, regarding claim 13, Applicants cannot find in Diginosa nor Merz any recitation of a filler having an outer appearance "similar" to a window jamb liner. In rejecting this claim, the Office Action has not explained with any specificity on record how Diginosa and/or Merz would have suggested Applicants' claimed combination. According to the BPAI in *Ex parte Humphreys*, if the Office Action does not provide specific reasons to support an

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obviousness rejection, it will have failed to establish a *prima facie* case of obviousness, and the application will be allowed over the prior art. 24 USPQ2d 1255 (BPAI 1992).

For at least this reason, Applicants respectfully request reconsideration and withdrawal of this basis of rejection of claim 13.

Claim 23:

Applicants submit that the proposed combination of Diginosa and Merz is improper and fails to establish all elements recited in Applicants' claim 23. To this end, Applicants respectfully incorporate herein the relevant remarks asserted above with respect to claim 1 (i.e., among other things, (1) Diginosa teaches away from being combined with Merz and further teaches away from Applicants' claimed combination; (2) the proposed combination of Diginosa and Merz would result in a reference inoperable for its intended purpose, or at the very least, require substantial design; (3) the Office Action asserted motivation for combining Diginosa and Merz amounts to no more than a mere trade-off; and (4) neither Diginosa nor Merz recites a bracket portion providing reinforcement to the "interior" portion of a sash at a second position).

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this basis of rejection of claim 23. Claims 24-30 and 33 are dependent on claim 23 and are patentable over the cited references for the reasons remarked above, in addition to the elements in such claims.

Claim 25:

Additionally, regarding claim 25, Applicants cannot find in Diginosa nor Merz any recitation of a bracket assembly "substantially concealed" in the window jamb assembly from a "frontal view" when the bracket portion is disposed in the first position. To this end, Applicants respectfully incorporate herein the relevant remarks asserted above with respect to claim 3 (i.e., Diginosa and Merz recite an unconcealed bracket assembly disposed on or nailed to "the face" of a sash or jamb).

For at least this reason, Applicants respectfully request reconsideration and withdrawal of this basis of rejection of claim 25. Claim 33 is dependent on claim 25 and is patentable over the cited references for the reasons remarked above, in addition to the elements in such claim.

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Claim 27:

Additionally, regarding claim 27, Applicants cannot find in Diginosa nor Merz any recitation of one or more fasteners securing a bracket assembly to an outer frame "surrounding" the window jamb assembly. To this end, Applicants respectfully incorporate herein the relevant remarks asserted above with respect to claim 7 (i.e., Diginosa and Merz recite the securing of a base plate to a sash or jamb).

For at least this reason, Applicants respectfully request reconsideration and withdrawal of this basis of rejection of claim 27.

Claim 29:

Additionally, regarding claim 29, Applicants cannot find in Diginosa nor Merz any recitation of a filler having an outer appearance "similar" to one or both of a window jamb assembly or window jamb liner. To this end, Applicants respectfully incorporate herein the relevant remarks asserted above with respect to claim 13 (i.e., the Office Action has not explained with any specificity on record how Diginosa and/or Merz would have suggested Applicants' claimed combination).

For at least this reason, Applicants respectfully request reconsideration and withdrawal of this basis of rejection of claim 29.

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Reservation of Rights

In the interest of clarity and brevity, Applicants may not have equally addressed every assertion made in the Office Action; however, this does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, or the right to challenge or rebut any asserted factual or legal basis of any of the rejections. Applicants do not admit that any of the cited references or any other references of record is relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserve all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application.

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CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited and encouraged to telephone Applicants' attorney (612) 373-6956 to facilitate prosecution of this application.

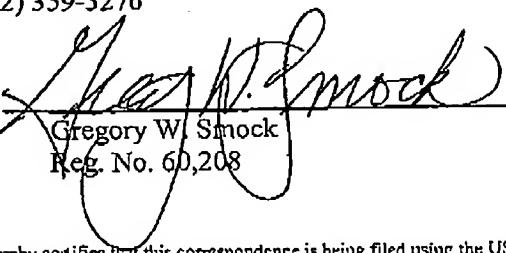
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 359-3276

Date January 2, 2008

By


Gregory W. Smock
Reg. No. 60,208

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 2nd day of January 2008 (day after Federal holiday).

CANDIS BUENDING

Name

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